

**AMENDMENTS TO THE DRAWINGS**

Please replace the original drawing sheet 2/3 with the enclosed sheet 2/3 labeled "Replacement Sheet." The replacement sheet of the drawings does not contain any new matter. For example, the new sheet includes subject matter as supported in the original claims 18 and 24. The replacement sheet simply includes additions to clarify the location of a memory support 13, 13A. Specifically, as amended, FIG. 3 includes a memory support 13A and FIG. 4 includes a memory support 13.

### **REMARKS**

In the Office Action, the Examiner allowed claims 7-10 and 27-39, objected to claims 24 and 25 and rejected claims 11 and 26. By this paper, Applicants have amended claims 11, 24 and 26. These amendments do not add any new matter. Upon entry of the amendments, claims 7-11 and 24-39 will remain pending in the present application and are believed to be in condition for allowance. In view of the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

#### **Objection to the Drawings**

In the Office Action, the Examiner objected to the drawings because the drawings failed to show the memory support recited in claims 24 and 25. By the present response, the specification and FIGS. 3 and 4 have been amended to more readily identify the claimed “memory support” feature. No new matter has been added. Accordingly, Applicants respectfully request withdrawal of the objection.

#### **Objection to Claims 24 and 25**

In the Office Action, the Examiner objected to claims 24 and 25, presumably due only to the concurrent objection to the drawings discussed above. By the present response the Applicants have amended the specification and drawings as described previously. It is believed the amendments resolve the objection to claims 24 and 25.

#### **Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 11 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Powers et al., U.S. Patent No. 6,360,120 (hereafter “Powers”) in view of Lin et al., U.S. Patent No. 6,289,243 (hereafter “Lin”); and in view of Powers combined with Hampele et al., U.S. Patent No. 5,713,927 (hereafter “Hampele”). Applicants respectfully traverse these rejections.

***Legal Precedent***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01(III). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002).

The wording of this rejection would seem to indicate that the Examiner would consider the storing of cable identification data “inherent” in the art. However, for the Examiner to rely on the theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter or recitation is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*,

17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

As discussed below, it is believed that the Examiner simply intended to indicate that, given the wording of the claims, cable identification data *could be* stored in the prior art arrangement.

#### ***Independent Claims 11 and 24***

As disclosed and claimed by the present application, the patient parameter cable is configured to provide a cable connection spanning the distance between patient sensors and a patient monitoring station. The parameter cable may include a cable, adapter for connecting the cable to the patient monitor station and a separate adapter for connecting the cable to one or more sensors.

Independent claim 11, recites, *inter alia*, “a memory device disposed in the station adapter and *configured to store cable identification data*” (emphasis added). Similarly, independent claim 24 recites, *inter alia*, “a memory device disposed in the memory support and *configured to store cable identification data*” (emphasis added).

Conversely, Powers does not disclose a memory device configured to store cable identification data. In contrast, Powers discloses a housing 40 that may include a memory module 32 configured to store data acquired during treatment. *See* Powers, col. 4, lines 51-24. Specifically, Powers states that “[d]ata collected during the patient treatment event is stored on the memory module 32 associated with the electrode connector (shown in FIGS. 2a-2c). The data collected includes, for example, full ECG data along with shock decisions and shock deliveries.” *Id.* at col. 4, lines 7-11. Powers goes on to describe other “events” that may be recorded in memory, none of which include “cable identification data.” *See id.* at col. 4, lines 11-30. Accordingly, Powers does not include all of the elements of claims 11 and 24, nor is there a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of Powers.

The Examiner relies on Lin and Hampele for disclosure of a sensor adapter. Lin merely provides a connector 44 that is connected to an adapter 52 that connects to two defibrillator pads 48 and 50. Hampele merely discloses a female connector 15' and a male connector 15 connected to two electrodes 9. Neither Lin nor Hampele disclose a memory configured to store cable identification data and, accordingly, neither reference obviates the deficiencies of Powers. For at least these reasons, Applicants respectfully request withdrawal of the rejections under §103, and allowance of the claim.

#### ***Independent Claim 26***

Independent claim 26, recites, *inter alia*, a “means for storing data, the means for storing data *storing at least parameter-cable identification information*” (emphasis added).

In contrast, as noted above, Powers discloses a memory module 32 that is configured to store data acquired during treatment such as full ECG data, shock decisions, shock deliveries and other “events” that may be recorded in memory, none of which

include “cable identification information.” *See id.* at col. 4, lines 11-30. The mere fact that the memory of Powers *can be combined or modified* to store cable identification information does not render the resultant combination obvious unless the prior art *also suggests* the desirability of the combination. M.P.E.P. § 2143.01(III).

There is no suggestion or motivation to combine the memory of Powers with the storing “at least parameter-cable identification information” as recited by independent claim 26. For instance, Powers merely discloses the need to “provide data collection for the *patient* which is incorporated into an electrode connector” (emphasis added). *See* Powers, col. 2, ll. 7-10. The data is generally collected from multiple defibrillators during treatment of the patient to compose a continuous ECG readout. *Id.* at 65-67. Accordingly, the memory disclosed by Powers is directed at collecting and storing data related to the patient’s treatment history. No mention is made of cable identification data or the desirability to create or to store such data. Neither Lin nor Hampele obviates these deficiencies, as discussed above.

Further, the Examiner stated that the memory of Powers can inherently store any type of data, including cable-identification data. *See* Office Action, p. 3. However, the Examiner has not provided a basis in fact or technical reasoning to reasonably support the determination that storing cable-identification data *necessarily flows* from the teaching of Powers or would even be reasonable. To suggest that storing cable identification data is inherent would be tantamount to stating that cable assemblies used to connect to defibrillators *necessarily* include memory to store cable-identification information.

Moreover, the secondary references cited by the Examiner clearly indicate that storing cable identification information in a memory is not necessary. In fact, neither Lin nor Hampele discloses a memory disposed in the cable at all. Accordingly, Powers does not explicitly or inherently disclose “storing at least parameter-cable identification

information.” If the Examiner believes the functional limitation to be inherent in the cited reference, then the Applicants respectfully request that the Examiner provide evidence or scientific reasoning to establish the reasonableness of the Examiner’s belief that the functional limitation is an inherent characteristic of the prior art.

Accordingly, Powers does not include all of the elements of claim 26, nor is there a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of Powers, Lin or Hampele. For at least these reasons, Applicants respectfully request withdrawal of the rejections under §103, and allowance of the claim.

**Allowable Subject Matter**

In the Office Action, the Examiner indicated that claims 7-10 and 27-39 are allowed and that claims 24 and 25 are objected to because they are not supported by the drawings. By this paper, claim 24 has been amended. Applicants would like to thank the Examiner for indicating the allowability and potential allowability of the above claims.

**Conclusion**

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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